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| 10/039,066 | 01/04/2002 | John M. Shamoun | 12457-0002/JWE | 9125 |
| 32605 | 7590 | 05/28/2008 | EXAMINER | |
| MACPHERSON KWOK CHEN & HEID LLP | | | MATTHEWS, WILLIAM H | |
| 2033 GATEWAY PLACE | | | ART UNIT | PAPER NUMBER |
| SUITE 400 | | | 3774 | |
| SAN JOSE, CA 95110 | | | MAIL DATE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--|---|
| Office Action Summary | Application No. 10/039,066 | Applicant(s) SHAMOUN, JOHN M. |
| | Examiner William H. Matthews (Howie) | Art Unit 3774 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 February 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) Claim(s) is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) is/are objected to.
- 8) Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date
- 5) Notice of Informal Patent Application
- 6) Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-20 have been considered but are not persuasive. Note the Remarks received 2-22-08 omitted "page 13 of 15", but Examiner assumes the page 13 of 15 provided on 8-20-04 was intended to be included.
2. Applicant contends each of Broderick et al. and Onyshkevych et al. are non-analogous art and thus one of ordinary skill in the art of cosmetic surgery would not look to either reference for their teachings for combination with the cosmetic surgery preview image method of Massengill. Examiner disagrees because the claimed invention is directed towards using a network and user input, via questions, to create a preview image of a potential cosmetic or appearance change. Massengill provides the method substantially as claimed but lacks using images that are not of the patient. Furthermore, one of ordinary skill in the art, with regard to the claimed invention, may be considered in the cosmetic surgery arts or computer science arts because the methodology of using a network and user input to create a preview image is directed toward computer science. Clearly, one of ordinary skill in the art would be capable of recognizing the related teachings of computer based imaging methods for other cosmetic changes. Further evidence that these references are not non-analogous art is provided by Onyshkevych et al. where it is set forth that the preview imaging methodology is applicable to a wide variety of applications including cosmetic surgery, cosmetics, and prosthetics. Also see MPEP 2141.01(a)(I) which support Examiner's position that each

of Broderick et al. and Onyshkevych et al. are analogous art because the teachings therein are reasonably pertinent to the claimed subject matter.

Claim Objections

Claim 8 is objected to because of the following informalities: line 3 should include "the" before "body".

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massengill US 2002/0064302 and in view of Broderick et al. US 2003/0007123 or Onyshkevych et al. US PN 6,665,577.

Massengill discloses in abstract, paragraphs [0026], [0030]-[0034],[0048], and [0051] a method of providing a preview image of a cosmetic surgery procedure for the nose or breasts comprising asking multiple choice questions (including measurements) and using the answers over a network to form the image.

With regard to the newly added limitation to independent claims 1, 19, and 20, Massengill lacks the express written disclosure of performing the method without using an image of the patient.

Broderick et al. discloses in paragraphs [0051], [0054]-[0056],[0058],[0060], and [0063]-[0065] a method of providing a preview image of a cosmetic procedure for the eyes comprising asking multiple choice questions and using the answers over a network to form the image from a database of pre-existing images for the patient to select from and modify.

Onyshkevych et al. discloses in lines 1-18 of col. 16, lines 60 of col. 19 through line 5 of col. 20, and lines 43-53 of col. 22 a method of providing internet based transactions, including cosmetic surgery, in which the user may answer qualitative and/or quantitative questions to produce a digitized image from a database or select a similar image from a database in order to serve users unwilling to provide an actual physical image.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Massengill by using images not from the patient as taught by either of Onyshkevych and Broderick et al. in order to serve patients unwilling to provide an actual physical image.

With specific regard to claim 13, Massengill lacks the express disclosure of asking for the specific breast measurements described in claim 13. However, in the art of cosmetic surgery, it would have been obvious, if not inherent, to ask for measurements of the patient's breasts in order to provide pre-operative and post-operative comparison for the patient when performing breast enhancement procedures.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Massengill by including the step of

asking for specific breast measurements in order to provide pre-operative and post-operative comparison for the patient when performing breast enhancement procedures.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number

is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/
Primary Examiner
Art Unit 3774